

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

APR 21 1999

In re)
) Decision on
) Petition for Review
) Under 37 C.F.R. § 10.2(c)
_____)

MEMORANDUM AND ORDER

("Petitioner") seeks review of the decision of the Director of the Office of Enrollment and Discipline ("Director") denying Petitioner's request that he be granted a passing score on the afternoon section of the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office held on August 27, 1997. The petition is denied.

Background

Petitioner has taken the registration examination several times. He passed the morning section of both the April 8, 1992, and November 2, 1994, exams. In view of passing a morning section, he sat for only the afternoon section of the August 27, 1997, exam. Seventy points out of a possible 100 were needed to pass that section and Petitioner scored a 64.

Petitioner requested that the Director grant him a passing grade on the afternoon section of the 1997 exam. However, rather than show that his chosen answers should have been awarded

credit, Petitioner argued to the Director that the part of the afternoon section of the 1997 exam which had test takers choose three of four options, i.e., Part 3 of the exam, was unfairly graded in general, and he should therefore be awarded a passing score for the section. In the alternative, Petitioner requested the Director to waive the exam requirement and enroll him as a registered patent practitioner on the basis of his experience in the patent field.

The Director was not persuaded by Petitioner's arguments concerning the alleged improper overall grading of Part 3 of the afternoon exam. Additionally, the Director determined that Petitioner showed neither an extraordinary situation nor that justice required the waiver of the regulation, 37 C.F.R.

§ 10.7(b), that one must pass the registration examination prior to being admitted to practice before the Patent and Trademark Office ("PTO") in patent cases. She therefore denied his request to be admitted. Pursuant to 37 C.F.R. § 10.2(c), Petitioner seeks review of the Director's denial.

Opinion

The Commissioner of Patents and Trademarks:

may require [agents and attorneys], before being recognized as representatives of applicants or other persons, to show that they . . . are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

35 U.S.C. § 31 (emphasis added). Pursuant to this authority, the Commissioner promulgated the following regulation:

No individual will be registered to practice before the Office unless he or she shall:

. . . .
(2) Establish to the satisfaction of the Director that he or she is:

. . . .
(ii) Possessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants for patents valuable service.

37 C.F.R. § 10.7(a) (emphasis added). With respect to showing possession of the necessary legal qualifications:

each applicant for registration [except for former patent examiners of more than four years . . .] must take and pass an examination which is held from time to time.

37 C.F.R. § 10.7(b). Accordingly, pursuant to this regulation, Petitioner must show that he passed the afternoon section of the 1997 exam.

With respect to making this showing, however, Petitioner merely attacks the afternoon section of the 1997 exam and its grading. See, e.g., Petition at 2 ("had applicant chose option 6, (instead of options 3, 4, and 5) the alleged six point deficiency would have been overcome") (emphasis in original). In particular, he argues that (1) he should be granted a passing grade because the afternoon section of the August 27, 1997, exam had a format that differed from earlier afternoon sections of the exam, and (2) since he did not choose exam option 6, he was placed at a disadvantage given the grading of that option. Petition at 2-3.

With respect to Petitioner's "new format" of the exam argument, the Commissioner regulates admission to practice before the PTO in patent cases and, in doing so, may change the format of the exam from time to time. 35 U.S.C. § 31; 37 C.F.R. § 10.7(a)(2)(ii). See also Gager v. Ladd, 212 F. Supp. 671, 673, 136 USPQ 627, 628 (D.D.C. 1963) ("the primary responsibility for protection of the public from unqualified practitioners before the Patent Office rests in the Commissioner of Patents") (quoting with approval Cupples v. Marzall, 101 F. Supp. 579, 583, 92 USPQ 169, 172 (D.D.C. 1952), aff'd, 204 F.2d 58, 97 USPQ 1 (D.C. Cir. 1953)); Leeds v. Mosbacher, 732 F. Supp. 198, 203,

14 USPQ2d 1455, 1458 (D.D.C. 1990) (representing applicants before the PTO in patent cases is "a highly specialized and technical position designed to protect and assist the public") (emphasis in original), aff'd mem., 918 F.2d 185 (Fed. Cir. 1990).

Significantly, in making this change, the Director informed each test taker, in his or her respective notice of admission to the examination, of the change in format. This notice expressly stated:

The Afternoon Section consists of three parts. Part One consists of SECTION 1 having 15 true/false questions . . . Part Two consists of SECTION 2 having 29 multiple choice questions . . . Part THREE consists of four OPTION SECTIONS . . . Each of the four OPTION SECTIONS consists of a fact pattern followed by three multiple choice questions.

The Director also informed the public of the change in format.

See Notice Regarding Examination For Registration On Wednesday,

August 27, 1997, 1200 Off. Gaz. 112-13 (July 29, 1997) (informing the public that the afternoon section format will change from claim drafting and responses to Office actions to multiple choice and true/false questions). Finally, the change applied to all test takers and did not place Petitioner at any disadvantage with respect to the other takers of the exam.

Accordingly, Petitioner's arguments concerning the above-discussed change in format are without merit. The change in format for the afternoon section of the 1997 exam does not entitle Petitioner to a passing score on that section of the exam.

As noted above, Petitioner also argues that he should have been awarded more points for his choice of Option 6 in Part 3 of the exam. This argument is also without merit.

More specifically, Part 3 of the afternoon section of the exam consisted of 4 options, Options 3-6. Each option had 3 questions, with each question worth 3 points. A test taker needed to choose 3 of the 4 options, for a total of 27 points. In Option 6, questions 1 and 3 were deleted. Thus, test takers who chose Option 6 received credit for these deleted questions. Petitioner chose Options 3, 4 and 5, receiving 9 points for Option 3, 6 points for Option 4, and 0 points for Option 5, for a total of 15 points for Part 3.

Petitioner now argues that he would have passed the afternoon section of the examination if he had "merely selected" Option 6. Petitioner's statement, however, is misleading. Petitioner would only have passed the afternoon section of the examination if he had selected Option 6 instead of Option 5.

If Petitioner had selected Option 6 instead of Option 3, or instead of Option 4, Petitioner would still not have received a passing score. For example, if Petitioner had selected Option 6 instead of Option 3, Petitioner would have received 6 points for Option 4, 0 points for Option 5, and 6 points for Option 6. This would have left him with only 12 points for Part 3, 3 points below what he actually received for Part 3. Even if Petitioner also answered question 2 of Option 6 correctly, he would still have only 15 points for Part 3, for a total score of 64.

Petitioner chose Options 3, 4, and 5, receiving only 15 points out of a possible 27 points. There is no basis for now awarding Petitioner points for an option he did not choose -- just because he might have chosen that option, as well as chosen to replace it for the option that yielded him the least points. Accordingly, Petitioner's argument concerning Part 3 of the exam is simply without merit.

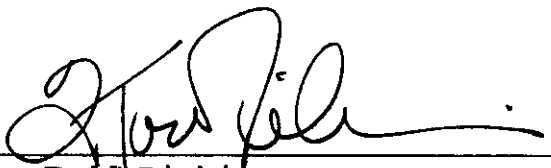
Petitioner also argues that he should be registered to practice before the PTO in patent cases, despite his not having passed the required exam, in view of: (1) his experience in the patent field; (2) the numerous times he took the registration exam; and (3) the Director not issuing her written denial of his request for a passing grade until after the August 26, 1998,

exam. Petition at 1-3. However, Petitioner's experience as a lawyer, even under the supervision of a registered patent practitioner, and his taking of the exam many times are not substitutes for the requirement of having passed the exam, as found in 37 C.F.R. § 10.7(b). Of course, failing an examination numerous times is hardly an argument to waive it. Also, a delay in issuing the Director's decision likewise does not obviate the requirement of having to pass the exam. See FTC v. J. Weingarten, Inc., 336 F.2d 687, 692 (5th Cir. 1964) (delay alone will very rarely establish bad faith), cert. denied, 380 U.S. 908 (1965). Petitioner was on notice at least three months prior to the filing deadline of the August 26, 1998, registration examination that he still needed a passing score on the afternoon section of the registration exam. Therefore, Petitioner had sufficient time to register for the next exam, in the event he was unsuccessful in his petition for a regrade.

ORDER

Upon consideration of the petition to the Commissioner for a passing score on the afternoon section of the August 27, 1997, registration examination, or for waiver of the requirement that Petitioner attain a passing score prior to being registered to practice before the PTO in patent cases, it is

ORDERED that the petition is denied.



Q. Todd Dickinson
Acting Assistant Secretary of Commerce
and Acting Commissioner of Patents and Trademarks